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Paper No. 40

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In re Application of
Koren et al.
Application No. 08/765,324 :
Filed: December 24, 1996 :
Attorney Docket No. OMRF 143 CIP (2) :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed February 13, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

A renewed petition may be filed, without fee, providing the appropriate evidentiary support to establish nonreceipt of the final Office Action, mailed June 18, 2000. If reconsideration of this decision is desired, petitioner should filed a reconsideration petition under 37 CFR 1.37(a) within TWO (2) MONTHS from the date of this decision. Extensions of this two-month time limit are available under 37 CFR 1.136(a). This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office Action of June 18, 2002, which set a reply period of (3) Three Months from the mail date of the Notice. Accordingly, the application became technically abandoned on September 19, 2002. The Notice of Abandonment was mailed January 29, 2003.

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See Withdrawing the Holding of Abandonment When Office Actions Are Not Received; Notice 1156 Off. Gaz. Pat. Office 53 (November 16, 1993).

Rather than relying upon docket records, the petitioner asserts that the Office Action, mailed on June 18, 2002, was never received by applicant's attorney of record. The petitioner acknowledges that an Amendment and Response was timely filed by applicant on March 5, 2002 in response to the Office Action, mailed on December 5, 2001. The petitioner asserts that Patrea Pabst, applicant's attorney of record, made attempts to determine the status of the case by leaving voice mail messages to the Examiner and her Supervisor, but that these voice mail messages were never returned. Petitioner further notes that the Examiner made no attempt to contact applicant's attorney of record prior to abandoning the case on June 18, 2002. Finally, the petitioner asserts that this application was abandoned only due to the failure of the Office Action to be received but a failure of the Examiner to respond to abandoning the case.

All business with the Patent and Trademark Office should be transacted in writing. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral communications in relation to which there is no record and there may be disagreement or doubt. See MPEP 2002.01 and CFR 1.2. Here, the written record shows that the final Office Action of June 18, 2002 was mailed to applicant's address of record, which is consistent with applicant's current address set forth in the petition under 37 CFR 1.137(a), filed February 13, 2003. Therefore, petitioner does not support the assertion of lack of receipt of the Office Action in question in a manner which satisfies the notice that satisfies the requirements found in the Notice published in 1156 OG 53 regarding the minimum requirements for establishing nonreceipt of Office correspondence (see MPEP 711.03(c)).

Further, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994)(while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

In the absence of the submission of a showing as discussed herein, there is presently no basis for grating the relief requested.

For applicant's convenience, final Office Action of June 18, 200 (Paper No. 37) and Notice of Abandonment of January 29, 2003 (Paper No. 38) are attached to this Decision.

Alternatively, petitioner may wish to consider filing a petition under 1.137(b) for unintentional abandonment. A reply required for such consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, the filing of a request for continued examination (RCE), or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2)(b). Jurisdiction with respect to such a petition also is in the Office of Petitions. An unintentional petition under 37 CFR 1.137(b) must be accompanied by the $1300.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
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Telephone inquiries concerning this decision should be directed to Phillip Gambel at (703) 305-4066.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

Attachments: Final Office Action of June 18, 2002 (Paper No. 37)
Notice of Abandonment of January 29, 2003 (Paper No. 38)